

REMARKS

Applicants respectfully request reconsideration and allowances of the present application in view of the foregoing amendments and in view of the following remarks.

Claims 20-49 are pending in this application.

1. The Rejections under 35 U.S.C. § 112, second paragraph

Claims 21 and 34 stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to specify the basis for the claimed weight percent values. According to the Office, it is not clear if the weight percent values are based on the weight of the prepolymer or the composition.

Applicants have obviated this rejection by amending claims 21 and 34 to explicitly state that it is the prepolymer that has a toluene diisocyanate content below 0.4% by weight.

2. The Rejection of Claims 20-23, 27, 29, 33-36, 39, 41-43 and 49 under 35 U.S.C. § 102(b) in view of JP 6-16767

The foregoing claims stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP 6-16767. Applicants have obviated this ground for rejection by amending independent claims 20 and 33 to recite limitations that are not taught or suggested by JP 6-16767.

Independent claim 20 has been amended to limit the R2 group of formula IIA to hydrogen or an alkyl-substituted C2-C6 alkyl group, neither of which are believed to be disclosed by JP 6-16767.

Independent claim 33 has been amended to recite that the process steps are all carried out at **room temperature** (support for which is found in the specification at page 1, paragraph 1; page 2, first full paragraph and the paragraph bridging pages 3 and 4; and Examples 1-3). JP 6-

16767 does not disclose a process wherein any step is carried out at room temperature. For example, paragraph 20 of the translation (page7) states as follows (emphasis added):

“A concrete example of the elastomer production process according to the present invention will be illustrated as follows: Liquids A and B are respectively introduced into separate tanks, and **preheated** to 30-90°C, preferably to 50-70°C. The liquids are taken from these tanks through a pump capable of measuring both liquids individually and simultaneously, mixed usually under a pressure of 100-190 Kg/cm² G through a mixing head connected to a closed mold which is **preheated** to 30-90°C, preferably to 50-70°C, and injected into the mold. Usually, an elastomer can be obtained by demolding within 7 minutes. After demolding, after-curing may further be carried out at 50-120°C for 1-24 hours.”

None of the process steps described above are being carried out at room temperature. If the liquids and mold are preheated, then they are no longer at room temperature.

The remaining claims 22-23, 27, 29, 34-36, 41-43 and 49 either depend from or are linked to claims 20 or 33. Accordingly, Applicants respectfully request that the Examiner withdraw the 102(b) rejection.

3. The Rejection of Claims 20-32, 37, 38, 40, 44 and 46-48 under 35 U.S.C. § 103(a)

The foregoing claims stand rejected under 35 U.S.C. § 103(a) as unpatentable over JP 6-16767, in view of U.S. Patent 5,077,371 (Singh et al.), and further in view of U.S. Patent 5,817,860 (Rizk et al.), U.S. Patent 5,990,258 (Peter) and U.S. Patent 5,232,956 (Gabbard et al.). Applicants respectfully traverse.

The Office asserts that the primary reference (JP 6-16767) “discloses that the reaction proceeds at temperatures which overlap those of applicants”. As amended, claim 33 recites a process wherein all steps are carried out at room temperature. None of the process steps disclosed in JP 6-16767 are carried out at room temperature. Hence, there is no overlap between the process recited in the pending claims and the process disclosed in JP 6-16767.

The Office also asserts that “it would have been obvious to utilize temperatures below those disclosed [in JP 6-16767], thereby increasing pot-life, if one was unconcerned with the rapid processing times associated with reaction injection molding processes.” Yet, there is no suggestion in JP 6-16767 to modify the process so that it could be run at room temperature. JP 6-16767 is solely concerned with RIM processes. Furthermore, there is no evidence or teaching in JP 6-16767 that the only effect of temperature is on the rate of curing. Accordingly, the Office’s assertion regarding obviousness is speculative and unsupported by evidence.

Finally, the Office asserts that “it would have been obvious to incorporate the curing agent and plasticizers of the secondary references within the compositions of the primary reference, because it has been held that it is *prima facie* obvious to utilize a known component for its known function.” This is impermissible hindsight. Applicants’ invention provides room-temperature moldable and curable compositions by the nonobvious selection of a specific combination of ingredients, and in particular, the selection of a particular class of plasticizers. The disclosures in JP 6-16767 and the secondary references are very general, and the function of the plasticizer in these references appears to be entirely conventional. No specific properties are sought from the plasticizer used in these references, nor is there any indication that any particular plasticizer or group of plasticizers would have any particularly useful properties (such as minimizing distortion). Moreover, there is nothing in either the primary or secondary references to suggest a combination of components that would result in a composition capable of being cast and cured at room temperature. Any of a vast range of curing agents and plasticizers available in the prior art *could* be incorporated into the composition of JP 6-16767, but there is no indication anywhere in the prior art as to *which* curing agents and plasticizers, or indeed whether *any*

particular combination of curing agent and plasticizer would result in the highly desirable properties of room temperature castability and curability, and distortion control.

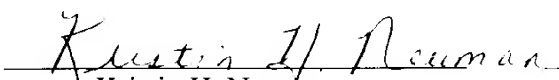
Applicants believe that the present application is now in condition for allowance. Favorable consideration of the application as amended is respectfully requested.

The Commissioner is authorized to charge any fee due, or credit any overcharge as a result of this Amendment and Response to Deposit Account No. 16-2500.

Respectfully submitted,
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By


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